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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,230	03/26/2001	Koji Nakamura	NEC01P015-ts	5805

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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,230

Applicant(s)

KOJI NAKAMURA

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/24/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is responsive to the Amendment and Response and the IDS dated 12/27/ 2004. The amended specifications and claims have been entered. Claims 1-45 are pending. Claims 1, 2, 25, 26, 29, 43 and 45 are independent.

Drawings

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. The previous rejection(s) as to claims 1, 25, 26, 43 and all their dependents is/are withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As to claim 2, 37, 38, 27, 39, 43-45 the previous rejection(s) is/are withdrawn.

5. Claims 3-4, 15-16 and 30 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

As to claims 3,4,30 (dependent on claims 1, 2, 29 respectively) , they are still grammatically unsound with “serves” and ‘comprises”, leading to confusion as to the scope of the claims. Appropriate corrections are required.

As to claims 15, 16, the previous rejection(s) is/are withdrawn.
However “other evaluating clients” should be “evaluating clients” so not to exclude the “evaluating client” earlier recited in the same claims. Appropriate correction is required.

Response to Arguments

6. Applicants’ arguments have been carefully reviewed but found unpersuasive. It is noted first that all Officially Noted facts, that have not been challenged are taken as admitted. MPEP 2144.03.

Due to the amendments , the previous art rejections under 35 USC 102 (e) are withdrawn and replaced by rejections under 35 USC 103(a) using the same references.

At page 14 of Applicant’s Response, Applicants argue Barney does not involve an Internet system. Please see at least col. 28 lines 5 to col. 30 lines 9, for Barney’s internet applications. At page 15, they argue that Barney involves a statistical database as a distinguishing feature from the claimed invention. Applicants are reminded that nothing in the claims preclude use of a statistical database such as Barney’s, when “comprising” is claimed.

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They further argue a method for “attracting users to a bulletin board”. A bulletin board (see discussion below) linking all parties via Internet is disclosed in Barney.

Regarding Applicants’ arguments at page 17, regarding the combination of references, Applicants are reminded that motivations have been provided for combining Barney and Lesandrini. Applicants did not submit specifically why the references would not or could not be combined.

Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey* 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Off*, 312 F.2d 937, 939, 136 USPQ 458,459 (CCPA 1963).

As to Applicants’ argument that the references address different problems and solutions, the ” law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. “*In re Beattie*, 24 USPQ2d 1040 (CA FC 1992).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney et al, US 6,556,992, herein Barney and further in view of Lesandrini et al, US 2002/0042733, herein Lesandrini.

Barney discloses postings of opinions and other information by some users regarding patents, (which each has its own bulletin board, **see at least col. 29 lines 45-48**), and wherein the posting users get rated and compensated based on their popularity i.e. based on number of times other users access the opinions/information that they posted (see at least col.29 lines 31 to col.30 lines 9; especially col. 29 lines 63-67). The posting users are also evaluated and compensated based on the quality of their postings i.e. on their veracity/accuracy as viewed by others (see at least col.29 lines 31 to col.30 lines 9; especially col. 29 lines 59-62).

Lesandrini discloses community websites, including chat rooms where ads are ranked and opined upon, for rewards points (see at least paragraphs [0009], [0104], [0130], [0224]) and where the community interaction promotes repeat visits and site loyalty (see at least p. 3, paragraphs [0074]).

Thus:

As to claims 1, 2, 25, 26, 29, 45, Barney (**see at least col. 28 lines 5 to col. 30 lines 9**) discloses a system/method using
a bulletin board (**see at least col. 29 lines 45-48**), comprising:
a plurality of clients;
an information transmitting server connected to said clients via the Internet, for supplying a bulletin board to said clients and giving a client a predetermined benefit depending on the level

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of reaction from another client (i.e. the consumer of the posted ratings/ opinions/ other information) with respect to an article which has been contributed to the bulletin board by said client; and
a customer information managing server for managing information of the clients including said benefit (see at least col.29 lines 59-64; col.30 lines 1-9).

Thus as to claims 1, 2, 25, 26, 29, 45, Barney does not specifically disclose electronically giving a benefit to the contributing users but LESANDRINI discloses such (e-points are given out, see at least page 1 [0009], page 3, [0063]).

It would have been obvious to one skilled in the art at the time the invention was made to add this teaching of LESANDRINI to Barney to promote the site as taught by Lesandrini (see at least page 1 [0009]) .

As to claims 3, 4, and 30 (dependent on claims 1, 2, and 29 respectively), BARNEY discloses:

said reaction from the other client serving as a criterion to give the client said benefit

comprises an evaluation made by said other client with respect to said article (based on evaluation of veracity/accuracy, see at least col.29 lines 31 to col.30 lines 9; especially col. 29 lines 59-62).

As to claims 5, 6, and 31 (dependent on claims 3, 4 and 29, respectively), BARNEY discloses the benefit is based on the number of answers (i.e. a quantitative value)from clients which have accessed and/or evaluated the article (see above, based on both popularity (number of accesses) and/or accuracy).

As to claims 7, 8 and 32 (dependent on claims 3, 4 and 30 respectively), BARNEY does not specifically disclose wherein the evaluation of the articles are made using a multiple values ("multivalued quantitative value").

However, Barney discloses ranking. Official Notice is taken that it is well-known to rank by using quantitative values according to several factors/attributes. Thus it would have been obvious to one skilled in the art at the time the invention was made to use multiple values (“multivalued quantitative value”) for ranking the Barney system because the subject matter (evaluation of patents) may be complex and requires more complex rankings systems as above discussed.

As to claims 9, 10 and 33 (dependent on claims 3, 4 and 30), Barney does not specifically disclose but LESANDRINI discloses rewarding the evaluating client based on the number of times that said evaluation has been entered (see above) . It would have been obvious to one skilled in the art at the time the invention was made to add this teaching of LESANDRINI to Barney to promote the site as taught by Lesandrini.

As to claims 11, 12 (dependent on claims 9 and 10), 34, Official Notice is taken that it is well-known setting a predetermined number of repetitions of any action as a criterion for a reward is well-known such as buying a number of gallons of milk to get a discount on a 7th one. The intent is to promote sales/use of the product/service the discount is designed to promote. Thus as Lesandrini discloses rewards for use of the bulletin board, it would have been obvious to one skilled in the art at the time the invention was made to add this common feature of a predetermined number of repetitions of the evaluations of the posted articles, to promote the site as taught by Lesandrini.

As to claims 13, 14, and 35 (dependent on claims 5, 6, and 32 respectively), Official Notice is taken that compensations are well-known to be calculated over predetermined accounting periods for ease of accounting. Thus it would have been obvious to one skilled in the art at the time the invention was made to set such a predetermined compensation accounting period to Barney’s methods for the above mentioned advantage.

As to claims 15, 16 and 38 (dependent on claims 5, 6 and 31 respectively) Barney implicitly discloses:

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evaluating the article by voting for or against the article (voting on the veracity of the article); and giving said client said benefit depending on the number of votes for the articles from the clients (based on evaluation of veracity/accuracy, see at least col.29 lines 31 to col. 30 lines 9; especially col. 29 lines 59-62).

As to claims 17, 18 (dependent on claims 1, 2), 27, 28, 39, and 43-44, Barney discloses all the limitations as disclosed above, in particular, evaluation of posted articles and compensation for postings depending on the evaluation by others (i.e. based on their popularity /veracity/accuracy).

Barney does not specifically disclose but LESANDRINI discloses the use of points for compensation (see at least paragraph [0009]). Adding points would have been obvious to be added to Barney as a common accounting means for rewards.

Further, neither Barney nor LESANDRINI specifically discloses displaying such evaluation to the posting party or the points assigned. However Official Notice is taken that it is well-known to communicate any message to anyone by for example email. Thus it would have been obvious to one skilled in the art at the time the invention was made to add to the Barney/LESANDRINI system a notification and display system to the posting authors to apprise them of the evaluations and compensations received from their postings as claimed.

As to claims 19, 20 and 40 (dependent on claims 1, 2, and 29 respectively), BARNEY discloses placing information other than the article contributed by the client on the bulletin board (see at least col. 29 lines 48-51).

As to claims 21, 22 and 41 (dependent on claims 1, 2, and 29 respectively), BARNEY discloses providing a plurality of bulletin boards for respective predetermined categories (see at least col. 29 lines 44-48).

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As to claims 23, 24 and 42 (dependent on claims 1, 2, and 29 respectively), BARNEY does not but LESANDRINI does disclose displaying the bulletin board following a page for purchasing merchandise (see at least paragraph [0146]). It would have been obvious to one skilled in the art at the time the invention was made to add to Barney the above LESANDRINI's teaching to provide e-commerce opportunities as taught by LESANDRINI (see at least paragraph [0146]).

As to claims 36, 37 (dependent on claims 30, 36) Barney does not specifically disclose said information transmitting server comprises means for rejecting an evaluation of the same article from the same client which has contributed the article. However Official Notice is taken that it is well-known to reject evaluation from the authors of their own articles. Thus it would have been obvious to one skilled in the art at the time the invention was made to add this feature to the Barney system to ensure integrity of the evaluation system.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov. (However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. (After our Art Unit moves to the Alexandria campus, sometime during or after April 2005, the Examiner's phone number will be 571-272-6721 and Mr. Eric Stamber's will be 571-272-6724. The current numbers are still in service until the move). The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

March 17, 2005

KHL



JAMES W. MYHRE
PRIMARY EXAMINER